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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/852,424 | 05/09/2001 | Christopher R. Tudan | SMAR014 | 5001 |
| 24353 | 7590 | 03/16/2004 | EXAMINER | |
| BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025 | | | SULLIVAN, DANIEL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1636 | |

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/852,424

Applicant(s)

TUDAN ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4,6-9,21.

Claim(s) withdrawn from consideration: 5,10-20.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


DAVID GUZO
PRIMARY EXAMINER

Continuation of 2. NOTE: The claims have been amended such that the CXCR4 antagonist now includes "an amino acid analog" of SEQ ID NO: 1 "having at least 50% identity to SDF-1[P2G](SEQ ID NO: 1)". First, the characterization of an amino acid analog as having 50% identity to a polypeptide sequence is inconsistent with the common meaning of "amino acid analog" because the phrase typically refers to modified amino acids or non-naturally occurring amino acids (e.g., 1,3-thiazolidine-4-carboxylic acid [thiaproline, Pro(S)]) not variants of an amino acid sequence containing naturally occurring amino acids. Therefore, the amendment might raise new grounds for rejection under 35 U.S.C. §112, second paragraph. It is noted that the specification identifies amino acid sequence variants as "polypeptides" (see page 20). Next, the new structural limitation of "50% identity" significantly changes the scope of the "analog" of the claims. Therefore, additional search and examination is required to determine patentability of the claims.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are directed to the claims as amended in the 20 February Paper and, as the amendment has not been entered, do not apply to the presently pending claims. However, it is noted that, had the amendment been entered, rejection of the claims under 35 U.S.C. §112, first paragraph, as lacking enablement beyond the scope of promoting the rate of BFU-E or CFU-GM multiplication would be overcome..

Continuation of 10. Other: Applicant's perfection of a priority claim to Canadian application 2,305,787 by filing Declarations executed by inventors Christopher R. Tudan, Ahmed Merzouk, Arab Lakhdar, Geeta Saxena, Connie J. Eaves, and Joanne Cashman, and by the legal representatives of inventor Ian Clark-Lewis is acknowledged..